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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/449,532 | 11/29/99 | LURIA | S 916/13 |

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| EXAMINER |
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LEFFERS JR, G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1636

DATE MAILED:

10/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/449,532

Applicant(s)

Luria, Sylvie

Examiner
Gerald G. Leffers Jr.

Group Art Unit
1636



☒ Responsive to communication(s) filed on Aug 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-134 is/are pending in the application.

Of the above, claim(s) 1-23, 49-91, and 114-134 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-48 and 92-113 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Acknowledgment is made of applicants election without traverse of Group II (claims 24-48 and 92-113) in the paper filed 8/4/00. Upon further review of the specification, the species election requirement has been withdrawn by the examiner. Currently, claims 1-134 are pending, with claims 1-23, 49-91 and 114-134 being withdrawn from consideration as being drawn to non-elected inventions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-48 and 92-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 92 and 103 are vague and indefinite in that the phrase "...each of said plurality of second expression constructs of said expression library.." can be read two different ways. One way the phrase can be read is as addressing a number of different pluralities of second expression constructs. The second way, which appears to be what is intended by applicant, is that each member of the plurality of second constructs comprises a second coding region. It would be remedial to amend the claim language to more clearly indicate the phrase is referring to each

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individual construct within a single plurality of expression construct rather than to a number of different pluralities of expression constructs.

Claim 24 is vague and indefinite in that the metes and bounds of the phrase "...a level of expression of said reporter molecule.." are unclear. Would any level of expression for the reporter molecule constitute an indication of regulation by the expressed, unknown polypeptide? It seems upon reading the specification that some sort of comparison to a control construct or predetermined level of expression is intended by the phrase. It would be remedial to amend the claim language to clearly indicate what is meant by a "level" of reporter gene expression.

Claims 44, 109 are vague and indefinite in that the metes and bounds of the term "...portion of a polynucleotide sequence.." are unclear. How much of a nucleotide sequence must be present for it to be considered a "portion" of the original nucleotide sequence? Would a single nucleotide constitute being a "portion" of another nucleotide sequence in the context of this claim? It would be remedial to amend the claim language to clearly indicate what is intended by a "portion" of a nucleotide sequence.

Claims 47 and 112 are vague and indefinite in that the metes and bounds of the phrase "...a portion of a characterized protein.." are vague and indefinite. What exactly constitutes a "portion" of a characterized protein? Would a single amino acid satisfy the requirement for a portion of a characterized protein? It would be remedial to amend the claim language to clearly indicate what is intended by the term "portion" of a characterized protein.

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Conclusion

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Leffers, Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on Monday through Friday, from about 9:00 AM to about 5:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than 24 hours after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

DAVID GUZO
PRIMARY EXAMINER
David Guzo

GAJ
G. Leffers, Jr.
Patent Examiner
Art Unit 1636

October 23, 2000